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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/057,199	01/25/2002	Jeff Powell	60426-405/2002P01070US	3319

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SIEMENS CORPORATION
INTELLECTUAL PROPERTY LAW DEPARTMENT
170 WOOD AVENUE SOUTH
ISELIN, NJ 08830

EXAMINER

COMPTON, ERIC B

ART UNIT	PAPER NUMBER
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3726

DATE MAILED: 07/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/057,199

Applicant(s)

POWELL, JEFF

Examiner

Eric B. Compton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-18 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 14-18 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.

- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 14 and 16-17 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 2,358,510 to Holland et al.

Regarding claim 14, Holland et al disclose a method of forming a compression limiter (22, 29) for a suspension unit comprising the steps of:

forming a plurality of protrusions (24-26, 31-33) along a lower edge of a sheet of stock; and

roll forming said sheet of stock to form said compression limiter (see Col. 4, lines 57-68).

Note: the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). Furthermore, the preamble is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self-contained description of the structure not depending for completeness upon the introductory clause. *Kropa v. Robie*, 88 USPQ 478 (CCPA 1951).

Regarding claim 16, the protrusions are formed by stamping notches in a lower edge of a sheet of stock and bending the protrusions (see Col. 4, line 57-68). Furthermore, the protrusions appear in the Figures to be 90 degrees from the sheet of stock.

Regarding claim 17, after the edges of the sheet have been rolled a gap (23) is formed.

3. Claims 14 and 17-18 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over U.S. Patent 2,686,547 to Becker.

Regarding claim 14, Becker discloses a method of forming a compression limiter (2, see Col. 1, lines 29-35) for deformable anchor assembly comprising the steps of:
forming a plurality of protrusions (10) along a lower edge of a sheet of stock; and
forming said sheet of stock to form said compression limiter.

Note: the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). Furthermore, the preamble is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self-contained description of the structure not depending for completeness upon the introductory clause. *Kropa v. Robie*, 88 USPQ 478 (CCPA 1951).

While the step of roll forming is not explicitly disclosed it is believed that this step is inherently taught by Becker or, in the alternative, it would have been obvious to one

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having ordinary skill in the art at the time the invention was made to have roll formed sheet of Becker, in light of the teachings of Holland et al, *supra*, in order to form a tubular of any desired diameter from sheet metal.

Regarding claim 17, after the edges of the sheet have been rolled a gap (11) is formed.

Regarding claim 18, in the embodiment in Figure 12, angled portions (23) are provided along the lower edge of the sheet located between the protrusions (24) and the sheet (26).

4. Claims 14 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 99/25599 to Gass (COSMA Intl). EP 1 032 524 is an English language equivalent.

Regarding claim 14, Gass discloses a method of forming a compression limiter, spacer for (72) for a panel comprising the steps of:

forming a plurality of protrusions (56) along a lower edge of a sheet of stock (50, Figure 2); and

roll forming said sheet of stock to form said compression limiter (see Figure 6-7).

Note: the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). Furthermore, the preamble is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self-contained description of the structure not depending for completeness upon the introductory clause. *Kropa v. Robie*, 88 USPQ 478 (CCPA 1951).

Regarding claim 17, after the edges of the sheet have been rolled a gap (see Figure 8) is formed.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims rejected under 35 U.S.C. 103(a) as being unpatentable over either Holland et al, Becker or Gass.

Holland et al, Becker or Gass disclose the invention above, but do not disclose a high carbon steel sheet.

Regarding claim 15, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have formed the compression limiter from high carbon steel, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Prior Art References

The prior art references listed on the enclosed PTO-892, but not used in a rejection of the claims, are cited for their teachings of forming compression limiters.

U.S. Patent 1,497,859 to Lilly discloses a washer formed by a process (Col. 2, lines 93-95) similar to Applicant's.

U.S. Patent 2,275,315 to Ray discloses a compression limiter having a flange comprising a number of cut protrusions. See Col. 1, lines 34-36.

U.S. Patent 3,156,281 to Demi discloses a washer having an identical structure to Applicant's claimed compression limiter and inherently formed by the same method steps.

U.S. Patent 4,941,769 to Natsume discloses a compression limiter having a number of protrusions (52, Figure 10) or may include a gar (41, Figure 9).

U.S. Patent 5,704,752 to Logerot discloses a rivet device having an identical structure to Applicant's claimed compression limiter and formed by the same method steps (Col. 2, lines 39-41).

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric B. Compton whose telephone number is (703) 305-0240. The examiner can normally be reached on M-F, 9-5.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory M. Vidovich can be reached on (703) 308-1513. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.



Eric Compton
Patent Examiner
A/U 3726

July 10, 2003